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09/553,413	04/20/2000	Dominique Briere	11496-195086	5942

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EXAMINER

DAVIS, ROBERT B

ART UNIT	PAPER NUMBER
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1722

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**MAILED**  
JUN 07 2005  
**GROUP 1700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/553,413  
Filing Date: April 20, 2000  
Appellant(s): BRIERE ET AL.

**MAILED**  
JUN 07 2005  
**GROUP 1700**

Jeffrey E. Young and J. Scott Anderson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 18 May 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Claims 15-21 and 34-40 stand or fall together in regards to the recapture rejection. Claims 1-14, 15-21 and 34-40 stand rejected under 37 CFR § 1.175(b)(1). Claims 15-21 and 34-40 stand rejected under 35 USC § 251 as being an improper recapture of subject matter surrendered during the prosecution of Application No. 08/945,089, which issued as US Patent No. 5,968,560. Claims 1-14 have not been amended in this reissue and are not subject to the recapture rejection.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 15, 35, 36 and 39 have been amended in the amendment filed May 30, 2003. The change equates to an error, which was not covered by a prior declaration.

Claims 1-21 and 34-40 stand rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claims 15-21 and 34-40 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application

Art Unit: 1722

for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Original claim 1 of the patent included the following limitations.

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections

for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

The claim was amended to recite the following:

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Claims 15, 35, 36 and 39 of the reissue application have the limitation "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures". However, applicant argues that the two mold carriers are not a structural element of the claim.

Hence, these claims are broader than the patent claim 1. Further, the subject matter of original claim 1 was amended to overcome an art rejection. Applicant added to the

Art Unit: 1722

limitation of “two mold carriers” the following phrase “which are made in the form of enveloping structures”. On page 6 of the amendment filed September 28, 1998, applicant argues the following:

“Appel does not teach or suggest a device with mold carriers which sound (typo for surround) respective shell holders. Moreover, even if one imagines that elements 43, 44 in Appel are shell holders, that elements, 130, 131 are shells and that elements (axis and arms 118-121) are mold carriers, such an argument would be erroneous from a structural point of view. This is true for at least the reason that the above-mentioned elements are obviously pivot elements corresponding to axis 4 of the present invention. Moreover, even assuming arguendo that rods 118-119 are mold carriers, said rods are surely not surrounding elements, and they cannot provide rigidity, contrary to standard mold-carriers.”

It is clear that the mold-carriers are positive structural elements of claim 1 of the patent. It is further clear that the limitation of the mold carriers was amended and argued by applicant to overcome a prior art rejection. The present claims 15, 35, 36 and 39 have been amended to further define the structure of the “at least one quick-fixing locking member”, but the absence of the mold carriers being in the shape of enveloping structures from these claims constitutes recapture as this limitation was amended and argued to overcome a prior art rejection. See *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

Consideration of Eggert:

The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003)(precedential opinion of an expanded panel of the Board) is not applicable to claims 15-21 and 34-40. In *Eggert*, the limitation relied-upon in the original patent prosecution to define over the prior art was not omitted in its entirety in the reissue claims, but rather was broadened. The reissue claims thus remained narrowed, as compared with the surrendered claim subject matter in the area related to (germane to) what was surrendered, and recapture was avoided in *Eggert*.

In the present instance, the reissue claims were narrowed, as compared with the surrendered claim subject matter only in areas not related to (not germane to) what was surrendered. The limitation “by two mold carriers (3) which can move one with respect to the other” in the claim 1 of the patent was further limited to recite “by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other”. The limitation of the two mold carriers was omitted in its entirety in claims 15, 35, 36 and 39 filed with the reissue application. Applicant attempted to overcome the recapture rejection by further limiting the shell holders as follows, “said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other”. However, the applicant clearly argued that the mold carriers were not a positive limitation of the claim. See remarks (9/12/2002), page 4, 4<sup>th</sup> paragraph. This argument clearly illustrates applicant’s intent to eliminate the mold carriers limitation and thus results in recapture.

In conclusion, the decision of *Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003)(precedential opinion of an expanded panel of the Board)



Art Unit: 1722

is not on point as to the issues at hand. As pointed out above, in *Eggert*, the relied-upon limitation was not omitted in its entirety, but rather was broadened. Thus, the Board found the claims to escape the recapture doctrine. In contrast in the present instance, the relied upon limitations are omitted in their entirety.

**(11) Response to Argument**

Appellant's arguments filed May 18, 2004 have been fully considered but they are not persuasive. Appellant argues that the reissue claims do not recapture surrendered subject matter because the mold carrier shape continues to be a required characteristic of the claimed article. Appellant further states that the reissue claims are narrower because the mold carrier shape continues to be required, and broader because the claims recite an article of manufacture that corresponds to the machine claims in the patent. The examiner respectfully disagrees with these positions. Appellant clearly states on page 4 of the remarks filed 21 September 2002 the following regarding the shape of the mold carriers: "The ability to be supported by two such mold carriers is a required characteristic of the shell holders, but the mold carriers per se are not elements of the mold assembly of the reissue claims." The shape of the mold carriers was surrendered to overcome a rejection in the prosecution of 08/945,089, see Amendment B and remarks filed 28 September 1998, appellant has provided a copy as Appendix F of the appeal brief filed 18 May 2004. It is the position of the examiner that since the mold carriers per se are not elements of the claims 15, 35, 36 and 39, these claims are attempting to recapture subject matter. The figures of the Patent 5,968,560 illustrate mold holders (9) having an abutting surface against the mold carriers (3) and it

Art Unit: 1722

is unclear to the examiner how the limitation "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other" actually structurally defines the shell holders. Appellant is attempting to obtain subcombination coverage when the shape of the mold carriers of the combination has been surrendered.

Appellant further states that the reissue claims (15, 35, 36 and 39) are narrower than the surrendered subject matter in an aspect germane to the rejection. The examiner respectfully disagrees as the mold carrier is not a per se element of the claims (15, 35, 36 and 39) and the claim language "said shell holders being shaped to be supported by two mold carriers in the form of enveloping structures" does not actually limit the structure of the shell holders. The fact that the mold carriers are in the form of enveloping structures does not impart structure to the shell holders, but merely defines the structure of the mold carriers. It can be seen from Figure 1 of the Patent (-560) that no special shape is given to the shell holders with respect to the mating surfaces that abut the mold carriers.

Appellant states that claims (15, 35, 36 and 39) are article of manufacture claims instead of a machine as claimed in Patent (-560) claims 1-14. The examiner does not agree. The article of manufacture with respect to the "mold assembly" or the "device for manufacturing containers" is the container which is blow molded. Claims 15, 35, 36 and 39 are related to claim 1 as subcombination and combination. Appellant further cites MPEP § 1412.02 and the fact specific example that a reissue for article claims which contain functional descriptive material stored on a computer-readable medium in

Art Unit: 1722

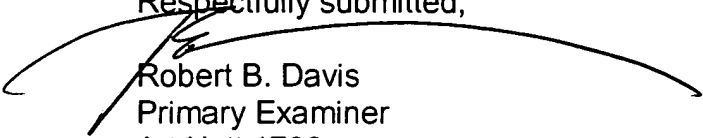
relation to machine or process claims in which the article claims are not broadening.

Appellant cites this example as support for the present "article of manufacture" claims in relation to the "machine" claims; however, the examiner does not believe that *Ex parte Wikdahl*, 10 USPQ2d, 1546 (Bd. Pat. App. & Inter. 1989) provides guidance for instances outside of the fact specific circumstances of article claims which are functional descriptive material stored on a computer-readable medium. Further, the examiner does not believe that the subcombination of the mold assembly is an article of manufacture in relation to the device for manufacturing containers. The examiner does not believe that the switch from the combination to the subcombination equates to a shift in statutory category, but irregardless of this point, *Ex parte Wikdahl* does not provide broad guidance that shifts of one invention to another are acceptable outside of the fact specific circumstances of the computer-readable medium in relation to a process or machine.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1722

Respectfully submitted,



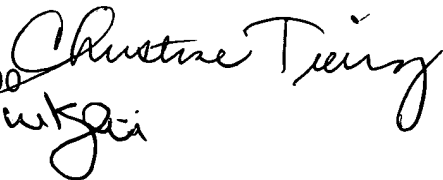
Robert B. Davis  
Primary Examiner  
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RBD

May 31, 2005

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